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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,005	10/20/1999	KOTA ARIYAMA	1614.1003	3533

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EXAMINER

MYERS, PAUL R

ART UNIT	PAPER NUMBER
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2112

DATE MAILED: 04/29/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/421,005

Applicant(s)

ARIYAMA, KOTA

Examiner

Paul R. Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claim 3, 4, 12 and 14 have been considered but are moot in view of the new ground(s) of rejection.

In regards to applicants argument that Gase does not teach the newly added feature of notifying the client of processing results sent from the peripheral to the client: Gase teaches that when there is a printer problem a message is automatically displayed for the user indicating the particular status problem. Thus when the processing results is a problem the client is notified of the processing results from the peripheral. However since the processing results can simply be the well known feature of informing the client that the print job has completed. The examiner is providing the reference to Yacoub PN 6,452,692 which expressly teaches this well known feature.

In regards to applicants argument that Gase does not perform protocol accommodation at server to allow client and its operated peripheral to communicate using different protocols: Gase teaches that as long as the proper modular I/O card is inserted a printer or plotter may be interfaced with any of a plurality of networks. Thus Gase does teach protocol accommodation however this function is performed by the I/O cards attached to printers to which the server communicates and not by the server. Moving this function to the server would be clearly obvious however the rejection is a 102 thus PN 5,987,228 to Nishizawa is being cited which teaches this feature and the rejection will not be made final.

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In regards to applicants argument that it would not have been obvious to combine Gase and Ooki: Gase et al further teaches if the driver is not available on the server uploading the driver from another location. In this case client processor 14 which serves as an overall system administrator. (See column 4 lines 27-34). Gase et al does not teach the location from which the driver can be uploaded being a printer. Ooki teaches that information relating to the characteristics of a printer includes the printer driver and that information relating to the characteristics of a printer may be stored in a ROM or the like of the printer.

In regards to applicants argument that Ooki does not discuss the OS being obtained from the printer: The examiner agrees. Since the claim language and applicants specification do not require storing the operating system in the printer this argument is moot. Gase et al teaches uploading a printer driver from another location. Ooki teaches storing information about the operation of the printer in the printer and uploading this information to the print server. Thus making the another location be the printer would have been obvious.

In regards to applicants argument that the motivation to combine must be found in a specific reference.

The test of obviousness is:

"whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," *In re Gorman*, 933 F.2d at 986, 18 USPQ 2d at 1888.

Subject matter is unpatentable under section 103 if it "'would have been obvious . . . to a person having ordinary skill in the art.' While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination." *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ 2d 1500, 1502 (Fed. Cir. 1988).

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"Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it addresses." *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979).

"In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found *in* a specific reference."

Entire quote from *In re Oetiker*, 24 USPQ 2d 1443 (CAFC 1992).

Accordingly, it is not required to disclose or specifically suggest particular elements. Instead the measure is what the teachings would suggest to one of ordinary skill in the art, not what the art specifically suggests.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 5-6, 8, 11 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Gase et al PN 5,580,177 in view of Yacoub PN 6,452,692.

In regards to claims 1, 6, 8, 11 and 15: Gase et al teaches a server (16) to which an operating client (10,12 or 14) and a peripheral apparatus (18, 20 or 22) to be operated by said operating client (10, 12 or 14) are connected, said server functioning as a peripheral server (file server - operates printers see abstract) with which the operating client (10, 12 or 14) operates the peripheral apparatus (18, 20 or 22), the server comprising: an instruction information storing part (Memory 34) which stores a set of operating instructions (printer drivers) to be used by said

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client apparatus (downloaded to client) to operate the peripheral apparatus (18, 20 or 22) via the server; and an instruction information send part (32) which reads said set of operating instructions (driver) from said instruction information storing part (34) in response to a request (print request) from said operating client (10, 12 or 14) and in further response sends (downloads) said instruction information (driver) to said operating client (10, 12 or 14), wherein the request (print request) is a request of the operating client (10, 12 or 14) to operate the peripheral apparatus (18, 20 or 22). Gase teaches notifying the client of problem results from the peripheral. Although this appears to be sufficient for the claim language. Gase does not expressly teach the results being the results of the processing. Yacoub teaches a printer sending a print job done message in response to the print processing request to the printer. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include processing results in the messages to the client because this would have allowed greater user control and information.

In regards to claim 5: Gase et al teaches the apparatus being a printer (18 or 20).

4. Claim 2, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gase et al PN 5,580,177 in view of Yacoub PN 6,452,692 as applied to claim 1 above, and further in view of Ooki PN 5,991,846.

In regards to claims 2, 7 and 9: Gase et al teaches the printer driver downloading as described above. Gase et al further teaches if the driver is not available on the server uploading the driver from another location. In this case client processor 14 which serves as an overall system administrator. (See column 4 lines 27-34). Gase et al does not teach the location from which the driver can be uploaded being a printer. Ooki teaches that information relating to the

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characteristics of a printer includes the printer driver and that information relating to the characteristics of a printer may be stored in a ROM or the like of the printer. (Column 6 lines 4-20). It would have been obvious to a person of ordinary skill in the art at the time of the invention to retrieve operating instructions from the apparatus to be operated because this would have allowed for quickly adding of new printers.

5. Claims 3, 4, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gase et al PN 5,580,177 in view of Yacoub PN 6,452,692 as applied to claim 1 above, and further in view of Nishizawa PN 5,987,228.

In regards to claims 3, 4, 12 and 14: Gase et al teaches the print server as described above. Gase et al also teaches handling different protocols including protocol conversion (Column 3 lines 29-50). Gase et al however teaches the protocol conversion being performed by the I/O modules as opposed to the print server. Nishizawa teaches a print server including a job receiving units that convert the received jobs from one protocol to the protocol used by the printer(s). It would have been obvious to a person of ordinary skill in the art to have the print server perform the protocol conversion because this would have alleviated the need for several different types of I/O modules.

In regards to claim 13: Gase et al teaches multiple clients.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

PN 5,228,118 to Sasaki teaches downloading printer control characteristics from a printer to a computer.

PN 6,003,069 to Cavill teaches downloading printer driver information to a client.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 703 305 9656. The examiner can normally be reached on Mon-Thur 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703 305 4815. The fax phone number for the organization where this application or proceeding is assigned is 703 746 7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 3900.



PAUL R. MYERS
PRIMARY EXAMINER

PRM
November 20, 2003